



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: J.K. JOUNG *et al.*

Serial No.: 10/532,258

Filed: April 21, 2005

For: CONTEXT SENSITIVE PARALLEL
OPTIMIZATION OF ZINC FINGER DNA
BINDING DOMAINS

Attorney Docket No.: 62031(51588)

Group Art Unit: Unknown

Examiner: Not Yet Assigned

Conf. No.: Unknown

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATION UNDER 37 C.F.R. §1.10

Date of Deposit: October 2, 2006

Mailing Label Number: EV855941985US

I hereby certify that this document is being deposited with the United States Postal Service on the date indicated above in an envelope as "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 and addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Denise Kacinski

Name of Person Mailing Paper

Denise Kacinski

Signature of Person Mailing Paper

DECLARATION OF SANDRA FAY-RICHARD, J.D., M.S.

I declare as follows:

1. From August 2004, I held the position of Licensing Associate in the Department of Corporate Sponsored Research and Licensing at Massachusetts General Hospital in Charlestown, Massachusetts. I have reviewed U.S. Patent Application No. 10/532,258 ("the present application"). I am familiar with the present application and its filing. I have been in contact with the inventors of the present application, Dr. J. KEITH JOUNG and Dr. CARL PABO. I respectfully submit that I am qualified to speak and render opinions as to the Petition Under 37 C.F.R.

1.47(a) filed May 18, 2006 and the circumstances surrounding the filing of the petition, as I have familiarity with both the present application and petition and their filings.

2. I am familiar with the Response to applicant's "Petition Under 37 C.F.R. 1.47(a)" issued by the United States Patent and Trademark Office in connection with the present application and make this Declaration in response thereto.
3. A bona fide attempt was made to present a copy of the Application papers to Dr. Carl Pabo, the non-signing inventor, for signature. The Declaration was provided to Dr. Pabo by the Department of Corporate Sponsored Research and Licensing. The attorney of record was instructed by the Department of Corporate Sponsored Research and Licensing to provide a copy of Application Serial No. 10/532,258 to Dr. Pabo. In e-mail correspondences dated February 23, 2006 and March 9, 2006 to Michele O'Shea, Invention Administrator for the Department of Corporate Sponsored Research and Licensing, Dr. Pabo confirmed receipt of the Declaration and Application Serial No. 10/532,285, respectively. Copies of Application Serial Nos. 60/420,458, filed October 23, 2002, and 60/466,889, filed April 30, 2003, were also provided to Dr. Pabo on March 20, 2006 by the Department of Corporate Sponsored Research and Licensing. Enclosed are copies of the e-mail documents that record the communications between Dr. Carl Pabo and the Department of Corporate Sponsored Research and Licensing.
4. There was express refusal by Dr. Carl Pabo to sign the Declaration. In an e-mail correspondence dated April 7, 2006, I asked Carl Pabo, "for the sake of clarity, would you kindly confirm that you decline to participate in prosecution of the above referenced patent application, including signing further documents relating to the patent prosecution?" Carl Pabo did not respond to the April 7, 2006 e-mail. In an e-mail correspondence dated April 13, 2006, I again asked Carl Pabo if he intended to decline participation in the prosecution of the patent. In an e-mail correspondence dated Thursday April 13, 2006 Carl Pabo indicated that "I would

like to decline participation in prosecution of this patent." Dr. Pabo indicated the circumstances of his refusal to be that he did not have "time to study the applications carefully enough to attest to the conditions set forth in the declaration." Enclosed are copies of the e-mail documents that record the communications I had with Dr. Carl Pabo.

5. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful statements

Dated Sept. 28, 2006

By Sandra Fay-Richard
Sandra Fay-Richard, J.D., M.S.
29 Walnut Street
Belmont, MA 02478



-----Original Message-----

From: Oshea, Michele A.

Sent: Monday, March 20, 2006 12:53 PM

To: 'Pabo, Carl Ogren'

Cc: Murthi, Jill; 'ALeahy@eapdlaw.com'

Subject: RE: Declaration document (MGH Case No. 2223)

Dear, Carl, in response to your request, attached please find additional documents pertaining to the above referenced case.

Let me know if the electronic copy is sufficient - we can still fedex the hard copies if necessary. When you have completed your review of the additional material, please let us know at your earliest convenience when you will be able to submit the Declaration document for this case. If you have any additional questions, feel free to contact Jill Murthi.

Thank you.

Regards,

Michele

-----Original Message-----

From: Pabo, Carl Ogren [mailto:Carl_Pabo@hms.harvard.edu]

Sent: Thursday, March 16, 2006 4:56 PM

To: Oshea, Michele A.

Subject: RE: Declaration document (MGH Case No. 2223)

Thanks for your note. I finally had a few more minutes to look at this declaration and the material that had been sent to me, but realized I've only been sent one of the three documents that I need. The patent application that was sent to me includes (by reference) U.S. application serial No. 60/420,458 filed October 23, 2002 and U.S. application serial No. 60/466,889 filed April 30, 2003. I will need copies of these before I can know whether it is appropriate for me to sign this declaration.
--- I'm also getting advice from my lawyer on how to handle this case.

Could they send these two earlier applications by Federal Express?

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Thanks for your help!

Best,
Carl

-----Original Message-----

From: Oshea, Michele A. [<mailto:MAOSHEA@PARTNERS.ORG>]
Sent: Thursday, March 16, 2006 10:34 AM
To: Pabo, Carl Ogren
Cc: Murthi, Jill; Aleahy@eapdlaw.com; Fay-Richard, Sandra L.
Subject: RE: Declaration document (MGH Case No. 2223)

Dear Carl,

I am writing to find out when you will submit the signed Declaration document for the above referenced case to our office. The first deadline to submit the document to the Patent Office was yesterday. The deadline to submit the Declaration is April 15th. We are now in an extension period, during which we need to pay additional fees to the Patent Office.

The Case Manager for this case, Sandra Fay Richard, is currently out of the office. If you have any questions regarding the Declaration document, feel free to contact Jill Murthi of our office. She can be reached at (617) 726-5406.

Thank you in advance for your prompt attention to this matter.

Regards,

Michele

-----Original Message-----

From: Pabo, Carl Ogren [mailto:Carl_Pabo@hms.harvard.edu]
Sent: Thursday, March 09, 2006 6:12 PM
To: Oshea, Michele A.
Subject: RE: Declaration document (MGH Case No. 2223)

Dear Michele,

Yes, I now have the patent application, and that's very helpful.

I still have some questions about exactly what one is "attesting to" when one signs a declaration of this form, but I'll try to get in touch

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with my lawyer tomorrow in the hope that we can sort this out as rapidly as possible.

Thanks again for your help!

Best,
Carl

-----Original Message-----

From: Oshea, Michele A. [<mailto:MAOSHEA@PARTNERS.ORG>]

Sent: Thursday, March 09, 2006 4:34 PM

To: Pabo, Carl Ogren

Cc: DKacinski@eapdlaw.com

Subject: RE: Declaration document (MGH Case No. 2223)

Carl, I wanted to confirm that you have all of the information you need to sign the Declaration. Can you please sign it and send it directly to Denise Kacinski at Edwards Angell Palmer and Dodge as soon as possible. Feel free to contact me if you have any additional questions.

Thank you.

Michele

Contact Information:

Edwards Angell Palmer & Dodge, LLP
301 Tresser Boulevard
Stamford, CT 06901

-----Original Message-----

From: Pabo, Carl Ogren [mailto:Carl_Pabo@hms.harvard.edu]

Sent: Thursday, February 23, 2006 3:50 PM

To: Oshea, Michele A.

Subject: RE: Declaration document (MGH Case No. 2223)

Thanks! --- I appreciate your help!

Best,
Carl

-----Original Message-----

From: Oshea, Michele A. [<mailto:MAOSHEA@PARTNERS.ORG>]

Sent: Thursday, February 23, 2006 1:35 PM

To: Pabo, Carl Ogren

9/27/2006

Subject: RE: Declaration document (MGH Case No. 2223)

I have written to the law firm and asked them to send you the information - to the address you provided.

Michele

-----Original Message-----

From: Pabo, Carl Ogren [mailto:Carl_Pabo@hms.harvard.edu]

Sent: Thursday, February 23, 2006 11:51 AM

To: Oshea, Michele A.

Subject: RE: Declaration document (MGH Case No. 2223)

Dear Michele,

I received the declaration form a few days ago and will do the best I can to deal with this. [Unfortunately, my life is very hectic right now since 1) the movers just arrived yesterday with all of my books, files, furniture and clothes and since 2) I need to go out of town for 4 days (returning to the office on Tuesday morning).]

At this point, I have one request as a next step: Could you kindly send me a copy of the document(s) that are relevant to this case? [The form you mailed asks me - in part - to confirm that "I have reviewed and understand the contents of the above identified specification...", and I can't do this without having the document(s). --- I know I had at least some of these at one point, but I think they probably are back in my storage unit in California.]

Thanks very much for your help with this! --- As before, the best address to use is the one at the Harvard Medical School that you had just used a few days ago.

Hope things are well!

Best,
Carl

9/27/2006



-----Original Message-----

From: Pabo, Carl Ogren [mailto:Carl_Pabo@hms.harvard.edu]
Sent: Thursday, April 13, 2006 12:20 PM
To: Fay-Richard, Sandra L.
Subject: RE: MGH 2223

Dear Sandra,

Thanks again for your help. Yes, I would like to decline participation in prosecution of this patent. --- As I mentioned, I am working under immense time pressure with other responsibilities. I do not feel I have been able, under these circumstances, to study the applications carefully enough to attest to the conditions set forth in the declaration.

Hope things are well, and thanks again for the chance to talk for a few minutes last week.

Best,
Carl

-----Original Message-----

From: Fay-Richard, Sandra L. [mailto:SFAYRICHARD@PARTNERS.ORG]
Sent: Thursday, April 13, 2006 11:19 AM
To: Pabo, Carl Ogren
Cc: Amy Leahy (E-mail)
Subject: MGH 2223
Importance: High

Dear Carl,

I hope you are well. Please let me know if you still intend to decline participation in prosecution of the patent we discussed last Friday. I need to provide appropriate instructions to the attorney by 4 PM today. If I have not heard from you by 4 PM today I will indicate to the attorney that you decline further participation.

with best regards,

Sandra

Sandra Fay-Richard J.D., M.S.

Licensing Associate

Corporate Sponsored Research & Licensing Massachusetts General Hospital Bldg. 149, 13th Street, Suite 5036 Charlestown, MA 02129

Tel: 617/724-2918

Fax: 617/726-1668

Email: sfayrichard@partners.org

-----Original Message-----

From: Fay-Richard, Sandra L.
Sent: Friday, April 07, 2006 4:40 PM

To: 'Pabo, Carl Ogren'
Subject: RE: MGH 2223; MIT 10544H Patent Application

Dear Carl,
Thanks for taking the time to speak with me today about the MGH-MIT (HHMI) jointly owned patent application, serial number PCT/US03/34010, entitled "Context Sensitive Parallel Optimization of Zinc Finger DNA Binding Domains". As we discussed, a signed Declaration is due in the patent office on or before April 15, 2006, and I am negotiating an Interinstitutional Agreement with my colleague, Tracy Huang at the MIT office. For the sake of clarity, would you kindly confirm that you decline to participate in prosecution of the above referenced patent application, including signing further documents relating to the patent prosecution?
As always, please feel free to contact me if you wish to discuss this further.

Sincerely,

Sandra

Sandra Fay-Richard J.D., M.S.

Licensing Associate

Corporate Sponsored Research & Licensing

Massachusetts General Hospital

Bldg. 149, 13th Street, Suite 5036

Charlestown, MA 02129

Tel: 617/724-2918

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Email: sfayrichard@partners.org

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Sandra

Sandra Fay-Richard J.D., M.S.

Licensing Associate

Corporate Sponsored Research & Licensing

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Bldg. 149, 13th Street, Suite 5036

Charlestown, MA 02129

Tel: 617/724-2918

Fax: 617/726-1668

Email: sfayrichard@partners.org



"Oshea, Michele A."
<MAOSHEA@PARTNE
RS.ORG>

02/23/2006 11:58 AM

To: <DKacinski@eapdlaw.com>, "Fay-Richard, Sandra L."
<SFAYRICHARD@PARTNERS.ORG>
cc: <MHeusch@eapdlaw.com>
Subject: RE: Our Ref: 51588.62031 Your Ref: MGH 2223

I finally reached Carl Pabo, who recently moved. I fedexed him the declaration. He has asked if he can have mailed to him all of the paperwork that needs to be reviewed in order to sign the declaration (application, etc.).

Can you please fedex this to him at his new address (he doesn't want it emailed as he is in transition and about to get a new address).

His new mailing address is:

Carl O. Pabo
HMS Sys Bio Department, WAB 536
200 Longwood Avenue'
Boston, MA 02115

His cell phone number (during his transition) is 415-847-5880

Thank you.

Regards,

Michele

-----Original Message-----

From: DKacinski@eapdlaw.com [mailto:DKacinski@eapdlaw.com]

Sent: Thursday, February 09, 2006 12:40 PM

To: Oshea, Michele A.; Fay-Richard, Sandra L.

Cc: MHeusch@eapdlaw.com

Subject: Our Ref: 51588.62031 Your Ref: MGH 2223

Dear Michele, Ms. Fay-Richard:

With reference to Marina Heusch's letter of January 4, 2006, please note we are still awaiting the executed declaration(s) for this application. A response to the Notification of Missing Requirements is due by February 15, 2006, but can be extended if necessary with payment of the required fees until June 15, 2006.

If you have any questions, please contact myself or Dr. Heusch directly.

Thank you for your help with this matter.

Denise

Denise M. Kacinski

Intellectual Property Assistant
203.353.6816 fax 203.975.7180
dkacinski@eapdlaw.com

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Three Stamford Plaza
301 Tresser Boulevard
Stamford, CT 06901 USA

Boston, Ft. Lauderdale, Hartford, New York, Providence, Short Hills, Stamford, West
Palm Beach, Wilmington, London (Representative office)

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